

REMARKS

Entry of the foregoing amendment is respectfully requested. The Amendment is believed to place the application in condition for allowances and is, therefore, appropriate under Rule 116. The Amendment does not raise any new issues and, thus, does not require an additional search by the Examiner.

The Amendment was not earlier presented because applicant became familiar with new grounds for rejection and a formal error in Claim 14 only after they were first set forth in the final Office Action.

By the present amendment, Claims 10-17 are amended to correct a spelling error therein. Claim 14 is also amended to correct a formal error therein.

Based on the foregoing amendments and the following remarks, the application is deemed to be in condition for allowance and action to that end is respectfully requested.

The Examiner rejected Claims 10-13 and 15-17 under 35 U.S.C. § 103(a) as being unpatentable over Sieger, U.S. Patent No. 2,076,969 (Sieger) in view

of Sato, U.S. Patent No. 5,207,138 (Sato). Claim 14 was rejected as claims above and further in view of Martin, U.S. Patent No. 3,037,396 (Martin).

It is respectfully submitted that Claims 10-17 are patentable over the cited references.

The present invention, as defined by independent Claims 10, 16 and 17 relates to high-speed transverse shears for cutting of a rolled strip to a length, and one of the main objects of the present invention is to obtain a precise cut of strips having a minimal thickness and transported with high speeds.

Sieger '969 relates to cropping shears for removing and disposing crop ends of strips leaving a rolling mill, and the object of Sieger '969 is to automate the crop end removing process. In Sieger '969 the to-be-cropped strip is guided to the shears (4) along a guide (16), and the cut-out end, after being cut-out, falls in a carriage (12) through a chute (11). Before a first cut is made, the strip is inclined by an upper roller (18) (page 2, right column, lines 59-68). When it is desirable to further transport the strip after a first cut, there is provided an adjustable apron (guide) (33) provided with a roller (34) for supporting the strip

after the first cut, and a downwardly inclined guide (35) for deflecting the end crops into a crop collector.

From the foregoing description, it clearly follows that Sieger '969, which relates to a totally different type of shears, is not pertinent to the present invention as defined by Claims 10, 16 and 17.

The present invention, as discussed above, relates to shears for cutting a rolled strip to a length, and it is respectfully submitted that the preamble along distinguishes the present invention, as defined by Claims 10, 16 and 17 over Sieger '969.

It is a long held view that the preamble is given the effect of a limitation, is deemed essential to point out the invention defined by a claim, and is "considered necessary to give life, meaning and vitality to the claims" when "there inhered in the article specified in the preamble a problem, when transcended that before prior artisan..." Kropa v. Robie and Maheman, 88 U.S.P.Q. 478, 481 (CCPA 1951). The same court further stated "The nature of the problem characterized the elements comprising the article, and recited in the body of the claim.... So as to distinguish the claim over the prior art."

The object of the present invention is high-speed transverse shears for cutting a rolled strip to a length and which insures a precise cut (length). It is the nature of the problem, which is encountered in the preamble that defines the elements recited in the body of respective claims. The preamble in the present case gives "life and meaning" to the structure recited in the body of the claim.

The Court of Appeals for Federal Circuit held that a preamble to a claim "has the import that the claim as a whole suggests for it." Bell Communication Research, Inc. v. Vitalink Communication Corp., 34 U.S.P.Q.2d 1816, 1820 (Fed. Cir. 1995). The same Court also held that "terms appearing in a preamble may be deemed limitation of a claim when they give meaning to the claim and properly defined the invention." London v. Carson Pirie Scott & Co., 20 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 1991). The limiting nature of the preamble to the claim was confirmed by the Court for Federal Circuit in its recent decision in Easton Corp. v. Rockwell International Corp., Fed. Cir. No. 01-1633, 03/27/03.

It is respectfully submitted that one of ordinary skill in the art and solving a problem of a precise cut of a strip to a length, would not look for

solution of the problem to Sieger '969, which is not in the field of applicants' endeavor and is not pertinent to the particular problem the applicants have solved.

The case law holds that:

In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.

In re Oetiker, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992).

Even assuming, *arguendo*, that Sieger '969 is a pertinent reference, it would not be obvious to provide therein two pinch-roller sets located in front of and behind the first and second drums, respectively, for advancing the rolled strip, under longitudinal tensioning, through a blade gap between the first and second drums.

The Board of Patent Appeals and Interferences stated that prior art must provide motivation or reason for worker in said art to make necessary changes in reference device . . . *Ex parte Chicago Rawhide Manufacturing Co.* 223 U.S.P.Q. 351 (PO Bd. App. 1984).

It is respectfully submitted that there is no motivation or reason to provide pinch-roller sets on opposite sides of the drum in Sieger '969.

According to the present invention, the pinch-roller sets are provided in order to advance the strip under longitudinal tensioning, which insures a precise cut. Sieger '969 does not require a precise cut as the cut-off piece is discarded. Further, in Sieger '969, with the strip end being cut, no advance under tensioning through the two drums can take place.

In view of the above, it is respectfully submitted that Sieger '969 does not make the present invention, as defined by Claims 10, 16 and 17, obvious, even in combination with Sato, and that the present invention, as defined by said claims, is patentable over Sieger '969.

Claims 11-15 depend on Claim 10 and are also submitted to be allowable.

COMMENT

Submitted herewith is a certified copy of the priority German Application DE – 199 53 908.1. It is respectfully requested that the receipt of the priority document be acknowledged.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects, in order to place the case in condition for final allowance, then it is respectfully requested that such amendment or correction be carried out by Examiner's amendment and the case passed to issue. Alternatively, should the

Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully Submitted,

Alexander Zinchuk
Alexander Zinchuk
Reg. No. 30,541

David Toren
Reg. No. 19,468

Dated: September 24, 2003
Sidley Austin Brown & Wood LLP
787 Seventh Avenue
New York, N.Y. 10019
Tel.: (212) 839-7355

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail and addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450 on September 24, 2003.

Alexander Zinchuk